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REMARKS

Claims 1, 4-8, 11-15, and 18-21 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Shaffer (U.S. Patent 6,092,114). Claims 2, 3, 9, 10, 16, and 17 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Shaffer (U.S. Patent 6,092,114) in view of Schwalm, *et al*, (U.S. Patent No. 5,339,361). As will be shown below, neither Shaffer nor Schwalm, either alone or in combination, teaches or suggests a method, system, or computer program product for email administration as claimed in the present application. Claims 1-21 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-21.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 4-8, 11-15, and 18-21 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Shaffer (U.S. Patent 6,092,114). Claims 2, 3, 9, 10, 16, and 17 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Shaffer (U.S. Patent 6,092,114) in view of Schwalm, *et al*, (U.S. Patent No. 5,339,361). Applicants respectfully traverse each rejection. To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaack*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

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**The References Do Not Teach Or Suggest
All Of Applicants' Claim Limitations**

In order to establish a prima facie case of obviousness under 35 U.S.C. § 103, Schaffer must teach or suggest all of Applicants' claim limitations. As discussed below, Schaffer does not teach or suggest all of Applicants' claim limitations. Independent claim 1 claims:

1. A method of email administration comprising the steps of:

receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain;

receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification;

finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes; and

sending at least one of the email display capability status attributes to the sender.

**Shaffer Neither Discloses Nor Suggests The
First Element Of The Independent Claims**

Regarding the first element of claims 1, 8 and 15, the Office Action states that Shaffer discloses at column 2, lines 30-65, and at column 6, lines 31-53:

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receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain ...

That is, the Office Action takes the position that Shaffer at column 2, lines 30-65, and column 6, lines 31-53, discloses the first element of claim 1. Applicants respectfully note in response, however, that what Shaffer at column 2, lines 30-65, in fact discloses is:

A method and system for exchanging electronic messages, such as email messages, include out-tasking conversions of file formats when it is determined that a client device does not include the resources to directly access an attachment without conversion. The access requirements of each attachment to electronic messages are compared to the capabilities of the client device to which the attachment is to be transferred. If it is determined that a file-format conversion is required, the conversion operation is assigned to a server that supports the process of reformatting the attachment. In an email environment, the server may be substantially equivalent to the conventional email server, but includes enhanced conversion capabilities.

In one embodiment, the determination of whether an attachment is accessible without conversion by a target client device occurs at the server. One means of enabling the server to execute the determination is to maintain a universal register of applications at the server. The universal register may be a lookup table that identifies each application program stored at each client device supported by the server. The lookup table may also include data that matches each user (i.e., potential recipient) with a client device at which the user typically accesses messages (e.g., a target computer). When a message is received at the server, the file format of any attachment is identified. In its simplest form, this is accomplished by looking at the file extension

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(e.g., .BMP identifies a bitmap graphics format and .MPEG indicates a specific video format). Alternatively, the format indicator may be embedded by the sending party within the message that includes the attachment. As a third possibility, the server may access each attachment in order to identify its file format. If a file-format conversion is necessary, the conversion can be implemented at the server, thereby freeing resources and processing time at the target client device. In this embodiment, the conversion may be transparent to the receiving party.

Furthermore, Applicants respectfully note in response, however, that what Shaffer at column 6, lines 31-53, in fact discloses is:

At step 44, the access capabilities of the target client device 14, 16 and 18 are determined. Referring to FIG. 1, an application register 34 may be maintained at the server level. As is well known in the art, computers typically maintain an application register of programs stored at the computer. The application register 34 of FIG. 2 may be considered to be a universal application register that identifies all of the access capabilities of various client devices that are used to access email stored at the local server 12. In one embodiment, the application register is maintained as a lookup table. When a client device is first used to access email stored at the local server, the client device is polled to identify its access capabilities. The polling process may also be used to periodically update a lookup table that is compiled within memory of the server or within memory of an adjunct device. While the format converter 30 and the application register 34 are shown as being connected to the local server 12, the operations of the converter and register may be integrated into known servers. As an alternative to the polling approach, the client devices 14, 16 and 18 may be

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programmed to identify their individual access capabilities each time that a program is upgraded or added to the client device.

The first element of claim 1 claims receipt of email display status attributes. The only thing received in Shaffer is email messages with attachments. Shaffer mentions not one word regarding email display capability status. Email display capability status is exemplified in the present application by display device availability (reference 1904 on Figure 19) and display device recent usage (reference 1906 on Figure 19), but there is nothing like this in Shaffer. Shaffer's receipt of email messages and attachments therefore neither discloses nor suggests receiving email display status attributes as claimed in the present application.

**Shaffer Neither Discloses Nor Suggests The
Second Element Of The Independent Claims**

Regarding the second element of claim 1, 8 and 15 the Office Action states that Shaffer discloses at column 6, lines 6-67, and column 7, lines 1-38:

Receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification ...

Paragraph 3 of the Office Action sets forth this further explanation of the rejection based on Shaffer:

a message sent by a sender to the server where a determination is made based on client capabilities, wherein said message would obviously be a default means of requesting capability status, especially in light of the fact that Shaffer discloses a capability status determination, a conversion means, and a notification to sender means, all related to the ability of the client/target device to receive the sender's message, and wherein the sender is notified of a client's inability to receive the

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message based on conversion requirements, which requirements are obviously an indication of the client/domain ability/capability to receive the senders message. Additionally, the motivation to request client capability is also found within Shaffer which teaches the need for files to be accessible to the client device as well as a conversion consideration, wherein both conversion time and data loss are important access file/sharing issues, (Col. 1, lines 55-67 & Col. 2, lines 1.27));

That is, the Office Action takes the position that Shaffer at column 6, lines 6-67 and column 7, lines 1-38 discloses the second element of claim 1, 8 and 15. Applicants respectfully note in response, however, that what Shaffer at column 6, lines 6-67 and column 7, lines 1-38 in fact discloses is transmission of an electronic message from a remote client device to a local server, identification of the file format of an attachment at the server level, determination of access capabilities of a target client device, determination whether the attachment is accessible at the target client device without conversion, conversion of the file format of the attachment locally or remotely as needed, and notification of the sender if conversion is not possible. None of which is a disclosure of receipt of an email display capability status request for a domain as claimed in the present application.

The fact that receipt of an email display capability status request for a domain is not disclosed or suggested in Shaffer is implicitly admitted by the Office Action's argument:

... a message sent by a sender to the server where a determination is made based on client capabilities, wherein said message would obviously be a default means of requesting capability status ...

That is, the Office Action argues that an email message is an email display capability status request for a domain, which it clearly is not. The email display capability status request as claimed here is a communication distinct from any email message, designed to

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inform a sender of email display capability status during preparation of an email message, so that the sender can avoid the entire process of trial and error disclosed in Shaffer. In addition, the access capability of Shaffer discloses access capability only, disclosing nothing whatsoever regarding display capability status. Nothing in Shaffer ever detects or advises whether a display capability is actually available, powered on, for example, when a capability was recently used, or any other actual status information.

**Shaffer Neither Discloses Nor Suggests The
Third Element Of The Independent Claims**

Regarding the third element of claim 1, 8 and 15, the Office Action states that Shaffer discloses at column 67, lines 6-67, and column 7, lines 1-38:

finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes,

Regarding this third element of claim 1, the Office Action argues on page 3:

Examiner notes that Shaffer discloses wherein if an attachment does not need conversion, it is transmitted to the client/target. Moreover, Shaffer teaches a checking, determining and converting process, wherein the client does not intervene with the same, and wherein the client/target email display capability status attributes are determinative of the need for sender notification and/or conversion) ...

That is, the Office Action takes the position that Shaffer at column 6, lines 6-67 and column 7, lines 1-38 discloses the third element of claim 1, 8 and 15. Applicants respectfully note in response, however, that what Shaffer at column 6, lines 6-67 and column 7, lines 1-38 in fact discloses is transmission of an electronic message from a remote client device to a local server, identification of the file format of an attachment at

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the server level, determination of access capabilities of a target client device, determination whether the attachment is accessible at the target client device without conversion, conversion of the file format of the attachment locally or remotely as needed, and notification of the sender if conversion is not possible. None of which is a disclosure of finding an email display capability status record for a domain as claimed in the present application.

The fact that finding an email display capability status record for a domain is not disclosed or suggested in Shaffer is implicitly admitted by the Office Action's argument:

... Moreover, Shaffer teaches a checking, determining and converting process, wherein the client does not intervene with the same ...

That is, the Office Action argues that Shaffer's checking and determining discloses finding an email display capability status record for a domain, which it clearly does not. Finding an email display capability status record for a domain as claimed here is a process that informs a sender of email display capability status for an entire destination domain during preparation of an email message, so that the sender can select a target device that is actually presently available and on-line, for example, and avoid the entire process of trial and error disclosed in Shaffer. In addition, the checking and determining of Shaffer is clearly oriented to a single target/client device and not to the display capability status of a domain as claimed here. Moreover, Shaffer's checking and determining administers access capability only, disclosing nothing whatsoever regarding display capability status. Nothing in Shaffer ever detects or advises whether a display capability is actually available, powered on, for example, when a capability was recently used, or any other actual status information.

**Shaffer Neither Discloses Nor Suggests The
Fourth Element Of The Independent Claims**

Regarding the fourth element of claim 1, 8 and 15, the Office Action states that Shaffer discloses at column 6, lines 6-67, and column 7, lines 1-38, sending at least one of the

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email display capability status attributes to the sender. That is, the Office Action takes the position that Shaffer at column 6, lines 6-67 and column 7, lines 1-38 discloses the fourth element of claim 1, 8 and 15. In addition regarding this fourth element of claim 1, the Office Action on the bottom page 3 and continuing on the top of page 4 argues:

... Examiner notes that Shaffer teaches sender notification concerning conversion requirements, which conversion requirement obviously represent client/target display capability status attributes ...

Applicants respectfully note in response, however, that what Shaffer at column 6, lines 6-67 and column 7, lines 1-38 in fact discloses is transmission of an electronic message from a remote client device to a local server, identification of the file format of an attachment at the server level, determination of access capabilities of a target client device, determination whether the attachment is accessible at the target client device without conversion, conversion of the file format of the attachment locally or remotely as needed, and notification of the sender if conversion is not possible. None of which is a disclosure of sending email display capability status attributes for a domain to a sender as claimed in the present application.

The fact that finding an email display capability status record for a domain is not disclosed or suggested in Shaffer is implicitly admitted by the Office Action's argument:

... Examiner notes that Shaffer teaches sender notification concerning conversion requirements, which conversion requirement obviously represent client/target display capability status attributes ...

That is, the Office Action argues that Shaffer's sender notification of conversion requirements discloses sending email display capability status attributes for a domain to a sender, which it clearly does not. Sending email display capability status attributes for a domain to a sender as claimed here is a process that informs a sender of email display capability status for an entire destination domain during preparation of an email message,

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so that the sender can select a target device that is actually presently available and on-line, for example, and avoid the entire process of trial and error disclosed in Shaffer. In addition, the sender notification of conversion requirements in Shaffer is clearly oriented to a single target/client device and not to the display capability status of a domain as claimed here. Moreover, Shaffer's sender notification of conversion requirements administers access capability only, disclosing nothing whatsoever regarding display capability status. Nothing in Shaffer ever detects or advises whether a display capability is actually available, powered on, for example, when a capability was recently used, or any other actual status information.

SHAFFER AND SCHWALM

Claims 2, 3, 9, 10, 16, and 17 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Shaffer (U.S. Patent 6,092,114) in view of Schwalm, *et al*, (U.S. Patent No. 5,339,361). The proposed combination of Shaffer with Schwalm cannot establish a *prima facie* case of obviousness because the proposed combination does not teach each and every element of the claims of the present application, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The Combination Of Shaffer and Schwalm Does Not Teach all Of Applicants' Claim Limitation

Because as shown above, Shaffer fails to disclose each and every element of independent claims 1, 8, and 15, the combination of Shaffer and Schwalm also fails to disclose each and every element of dependent claims 2, 3, 9, 10, 16, and 17. Because the Office Action cites Schwalm as teaching only additional claim limitations found in dependent claims 2, 3, 9, 10, 16, and 17, that is, limitations in addition to the limitations of the independent claims, the combination of Shaffer and Schwalm cannot disclose each and every element of the referenced dependent claims because Schaffer does not disclose or enable the limitations of the independent claims for the reasons set forth above. Claims 2, 3, 9, 10,

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16, and 17 are therefore patentable and the rejections under 35 U.S.C. § 103 should be withdrawn.

No Suggestion or Motivation to Combine Shaffer and Schwalm

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Shaffer and Schwalm. *In re Vaeck*, 947 F.2d at 493, 20 USPQ2d at 1442. The suggestion or motivation to combine Shaffer and Schwalm must come from the teaching of the references themselves, and the Examiner must explicitly point to the teaching within Shaffer or Schwalm suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action makes no mention whatsoever of any place in either of the references or elsewhere that suggests or provides any motivation for the proposed combination of Shaffer or Schwalm. In fact, the Office Action makes no clear mention of motivation to combine at all. The closest the Office Action comes to discussing motivation to combine is two cryptic references to obviousness in paragraph 9, page 7:

... wherein it **would have been obvious** to incorporate a sender verification means into the Shaffer system ...

and

... wherein it **would have been obvious** to augment the Shaffer controlled access means by implementing sender verification as well.

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Emphasis added. It is unclear, but perhaps these assertions of obviousness are intended somehow to show motivation to combine Shaffer and Schwalm. Applicants note in response, however, that these are both mere naked assertions for which no basis is provided from the art, neither from Shaffer, Schwalm, nor anywhere else.

**No Reasonable Expectation of Success in the
Proposed Combination of Shaffer and Schwalm**

To establish a *prima facie* case of obviousness, there must be a reasonable expectation of success in the proposed modification of Shaffer. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There can be no reasonable expectation of success in a proposed modification if the proposed modification changes the principle of operation of Shaffer. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The principle of operation of Shaffer is automating file format conversions for attachments to email messages – with particular focus on where the conversion is to occur. Schwalm is a communications security case, disclosing a system and method for authenticating transmission and receipt of facsimile messages. There can be no reasonable expectation of success in a proposed combination of file format conversion of Shaffer with facsimile message security of Schwalm to produce dynamic indications of client device status as claimed in the present application. The proposed modification of Shaffer by Schwalm therefore cannot possibly support a *prima facie* case of obviousness.

**Shaffer Teaches Away From Email Administration With
Dynamic Indications Of Client Device Status
As Claimed In The Present Application**

Shaffer actually teaches away from email administration with dynamic indications of client device status as claimed in the present application. Teaching away from the claims is a *per se* demonstration of lack of *prima facie* obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). The present application claims email administration with dynamic indications of client device status. Shaffer in contrast teaches email attachment file format

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conversion with no concern whatsoever for the actual status of any client device – thereby teaching directly away from the dynamic indications of client device status claimed in the present application. Even when the method of Shaffer finally gets around to advising a sender of a complete failure of conversion of an attachment, Shaffer never receives, detects, or communicates any information whatsoever regarding the status of the target device. Because Schaffer teaches away from email administration with dynamic indications of client device status as claimed in the present application, Shaffer cannot be used to support a prima facie case of obviousness.

Schwalm Is Nonanalogous Art

Schwalm is nonanalogous art and is therefore unavailable as a reference under 35 U.S.C § 103. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The field of endeavor of the present application is email administration with particular regard to dynamically indicating client device status for client devices for displaying digital objects included in email. Schwalm is a communications security case, disclosing a system and method for authenticating transmission and receipt of electronic information. The system of Schwalm is particularly oriented toward secure transmission of facsimile messages. An inventor attempting to solve problems related to displaying digital objects with email would never be reasonably expected to examine literature related to communications security for facsimile. The two are completely unrelated, that is, nonanalogous.

Relations Among Claims

Independent claim 1 claims method aspects of [preamble] according to embodiments of the present invention. Independent claims 8 and 15 respectively claim system and computer program product aspects of [preamble] according to embodiments of the present invention. Claim 1 is allowable for the reasons set forth above. Claims 8 and 15

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are allowable because claim 1 is allowable. The rejections of claims 8 and 15 therefore should be withdrawn, and claims 8 and 15 should be allowed.

Claims 2-7, 9-14, and 16-21 depend respectively from independent claims 1, 8, and 15. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Shaffer and Schwalm does not disclose or suggest each and every element of the independent claims, so also the combination of Shaffer and Schwalm cannot possibly disclose or suggest each and every element of any dependent claim. The rejections of Claims 2-7, 9-14, and 16-21 therefore should be withdrawn, and these claims also should be allowed.

Conclusion

Claims 1, 4-8, 11-15, and 18-21 stand rejected under 35 U.S.C § 103(a) as unpatentable over Shaffer and claims 2, 3, 9, 10, 16, and 17 stand rejected under 35 U.S.C § 103(a) as unpatentable over Shaffer in view of Schwalm. Schaffer alone or in combination with Schwalm does not disclose each and every element of Applicants' claims and does not enable Applicants' claims. Schaffer and Schwalm therefore do not anticipate Applicants' claims. Claims 1-21 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 1-21.

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The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447
for any fees required or overpaid.

Respectfully submitted,

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